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08/914,789	08/20/1997	CHARLES B. KATZ	C0464.097255	9133

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EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/91789

Applicant(s)

Nat'l

Examiner

Allen, G

Group Art Unit

2164

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 11/20/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 2-4, 6-10, 23 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 2-4, 6-10, 23 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to applicant's amendment filed 11/20/01(Paper #19).
2. Applicant had previously cancelled claims 1,5, and 11-22. New independent claim 23 was added in Amendment B(Paper #16).All other independent claims have been cancelled by applicant's Amendment B.
3. Amended claims 2-4,6-10 and new independent claim 23 are pending.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4,6-10,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whybrow ("Warehousing Benefits", Banking Technology, May 1995) in view of CFI Proservice's product "ProActive" (referenced by PR Newswire, 1994 (hereinafter referred to as "U"), by Prince, 1995 (hereinafter referred to as "V") and Business Journal-Portland, 1994 (hereinafter referred to as "W"). Whybrow's article recites the use of a "data warehouse", or repository, in a banking environment (abstract of article). Whybrow teaches "...data warehousing means putting a single database above a company's existing systems. The warehouse is fed by the underlying systems,

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data is held in a standard, consolidated format, and all management reporting and analysis is then driven from this repository" (paragraph 3).

6. Independent Claim 23: Whybrow teaches a method for "storing and compiling data for analysis and reporting..." (abstract) comprising:

"extracting data" (paragraph 3 and paragraph 6, "collecting" data); as well as parsing (paragraph 3) as well as "determining differences in data" (paragraphs 5 and 3) and "integrating" and "consolidation" (paragraph 7)

"reformatting said data" (paragraph 6, "translated" data, and paragraph 7);

"storing said formatted data, and integrating said stored data with previously stored data..." (abstract and paragraph 3); and

"preparing reports" (paragraph 3).

However, Whybrow does not specifically recite the step of "normalizing" the data and "preparing reports ...to indicate fair lending compliance." CFI Proservice's "ProActive" is a fair lending compliance software product which allows a bank to "collect, analyze, report, and map data related to lending and deposit activities" (reference "U", paragraph 6). ProActive "will generate HMDA reports in the electronic formats required by federal agencies..." (ref. "U", para. As stated in reference "U", ProActive allows a bank to analyze and report on fair lending compliance based upon a collection of data (paragraphs 6-9). Whybrow's repository is a collection of data in a standardized, consolidated format which can be used to generate management reports (paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of the

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applicant's invention to combine the use of the ProActive product with the data repository of Whybrow as the repository would provide the software product with the data needed to generate the required reports. The financial institution is required by law to provide information to the government to prove that they are meeting the standards of the fair lending laws. By establishing a data repository, and using a specialized compliance product, ProActive, the financial institution can meet those requirements in an efficient, streamlined fashion.

Regarding the step of "normalizing" the data, although this feature is not explicitly taught by the references, Official Notice is taken that the use of "normalization" techniques is old and well-known in the art of statistical analysis. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to normalize the data in order to create meaningful data for use in management reporting. (As evidenced by the article "Wessex's Pro/Filer makes desktop mapping easy" (Bank Marketing, 1994) note "Pro/Filer quickly computes, sums, averages, and normalizes ...." (para. 9) and "...a means of complying with CRA" (para. 12) ).

7. Claim 2: Whybrow teaches a method for "storing and compiling of data for analysis and reporting..." (paragraph 1), however, Whybrow does not teach the transmission of "said reports to at least one regulator of the financial institution." ProActive compliance software produces electronic reports which are sent to federal agencies, that is "regulators" (ref. U, para. 9). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit the reports to the regulator(s) of the financial institution as the reports are required by the

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fair lending laws, therefore, for a financial institution to remain in compliance with the law, the reports will be sent to the federal regulators.

8. Claim 3: Whybrow teaches a method for "storing and compiling of data fog analysis and reporting..." (paragraph 1) and ProActive compliance software produces electronic reports which are sent to federal agencies. However, the references do not specifically recited that the reports are sent on a "predetermined date", Official Notice is taken that reporting on a regular basis, "predetermined dates", is old and well-known in the regulation industry.-The fair lending laws, notably HMDA and CRA, require reporting from' financial institutions in order to determine if the institution is in compliance with the fair lending laws. It would have been obvious to one of ordinary skill in the art of regulation to require those institutions to report on a regular basis as this is the best means by which to establish a systematic approach to monitoring fair lending compliance.

9. Claim 4: Whybrow teaches a method for "storing and compiling of data for analysis and reporting..." (paragraph 1), and ProActive compliance software produces electronic reports which are sent to federal agencies. However, the references do not specifically recite that the regulators include the "OCC, FRS, FDIC, and OTS." Official Notice is taken that sending required regulatory reports (compliance reports) to the OCC, FRS, FDIC, and OTS is old and well-known in the art of regulation. It would have been obvious to one of ordinary skill in the art of regulation to send compliance reports to the federal regulatory agencies noted above because these agencies

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have the responsibility to perform federal regulatory duties. (As evidenced by the CRA and HMDA laws and numerous regulations - as an example please note the following:

Community Reinvestment Act Regulations (Vol. 58, Is: 243, Page: 67,466)

CITATION NUMBER: 58 FR 67466 Date: TUESDAY, DECEMBER 21, 1993

AGENCY: Office of the Comptroller of the Currency--(OCC); Federal Deposit Insurance Corporation-(FDIC); Federal Reserve System--(FRS); Office of Thrift Supervision--(OTS)

DOCUMENT TYPE: Proposed Rules

This citation is one of many documenting proposed rulemaking and rule changes by the agencies charged with monitoring fairness in lending; Note the agencies are OCC, FDIC, FRS, and OTS).

10. Claims 6 and 7: Whybrow teaches a method for "storing and compiling data for analysis and reporting...", including the step of data "extraction" (paras. 3 and 6), however, the reference does not discuss the frequency in which the data extraction, or collection, should be performed. Official Notice is taken that data warehouses, or repositories, often extract data and feed it into the repository at regular intervals. It would have been obvious to one of ordinary skill in the art of data warehouse management to regularly, notably monthly, collect data for the repository so that the repository is kept up-to-date. By maintaining the data in the repository on a regular basis, the reports generated from the repository will be up-to-date and more accurate than reports using older data.

11. Claims 8 and 9: These recite the method where the sources of data include "branches of the financial institution" (claim 8) and wherein the sources also include "at least one from the group of

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bankcard processing centers, student loan processing and business loan processing centers, and US territorial locations of the financial institution" (claim 9). Whybrow's data warehouse, or repository, system includes the step of "feeding" data to the warehouse from various "systems" (paragraphs 3 and 6), however, the reference does not explicitly state what those systems are. The ProActive compliance software generates reports for transmission to regulatory agencies. The federal regulatory agencies require that specific data be sent to them and the final result of this effort is that the regulatory agencies give the financial institution a rating. In order to do this, the federal agencies require that the data represent the financial institution as a whole, therefore, it is essential that the institutions collect the data from branch offices and any specialized processing centers under the auspices of the institution. It would have been obvious to one of ordinary skill in the art of banking, particularly compliance officers, to collect data from all business units of the bank in order to completely and accurately reflect the financial institutions' lending practices (as evidenced by the CRA and HMDA laws and regulations).

12. Claim 10: Whybrow teaches a method for "storing and compiling data ...for reporting", however, Whybrow does not specifically recite that the "reports include reports required by federal regulators under the fair lending laws." ProActive compliance software does include the feature of generating reports required by fair lending laws (ref. U, para. 9 and ref. V, para. 4). It would have been obvious to one of ordinary skill in the art of banking regulation to apply specific federally mandated report generation to the data warehouse of Whybrow. Whybrow's data



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warehouse provides for report generating, therefore, the 'specific' use of the data for fair lending requirements would be obvious to one skilled in the art because the data is accessible and the financial institutions are required by law to generate the report.

*Response to Arguments*

13. Applicant's arguments filed have been fully considered but they are not persuasive. Wybrow teaches reformatting data. "reformatting said data" (paragraph 6, "translated" data, and paragraph 7). Multiple times of reformatting are merely repetitions of the same process as taught in Whybrow. Whybrow teaches parsing of data and "extracting data" (paragraph 3 and paragraph 6, "collecting" data); as well as parsing (paragraph 3) as well as "determining differences in data" (paragraphs 5 and 3). Whybrow teaches also "integrating" and "consolidation" (paragraph 7).

The use of "normalization" techniques is old and is an established standard technique in the field of statistical analysis. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to normalize the data in order to create meaningful data for use in management reporting. (As evidenced by the article "Wessex's Pro/Filer makes desktop mapping easy" (Bank Marketing, 1994) note "Pro/Filer quickly computes, sums, averages, and normalizes ...." (para. 9) and "...a means of complying with CRA" (para. 12) ).

ProActive compliance software does teach the step of "geo-coding" data (ref. V paras 7-9 and ref U para 10). It is clear that one would utilize geocoding in creating banking compliance reports.

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This is so because geocoding is necessary so loan data can be analyzed in terms of geographical area and localized loan practices can be evaluated in the light of the communities where the financial institutions that are involved, service.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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15. Any inquiry concerning this communication should be directed to Geoffrey Akers whose telephone number is (703) 306-5844. The examiner can normally be reached Monday to Friday from 0630-1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, can be reached at (703) 308-1065. The fax number for Formal or Official faxes to Technology Center 2700 is (703) 3089051 or 9052. Draft or Information

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faxes for this Art Unit can be submitted to (703) 308-5357). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

GRA

February 11, 2002



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